

### **REMARKS**

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-2, 4-11, 13-16, 19-23 are pending in the application. Independent claims 1 and 11 have been amended to better define the claimed invention. New claim 24 which depends on claim 17 and includes a limitation similar to the added feature of claims 1 and 11 has been added to provide Applicants with the scope of protection to which they are believed entitled. Claim 19 has been amended to depend on claim 24. The amended claims find support in the original specification, e.g., page 12, lines 6-9, and the original drawings, e.g., FIGs. 3-4. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 112, *first paragraph* rejection of claims 21-23 as being unsupported by the application as filed is traversed, because the claims find solid support in the original specification at page 11, lines 20-22 and FIG. 3. In particular, the relevant portion of the specification discloses that "[t]he distance between the left face and right guide members 910L, 912L is substantially constant along the direction (arrow C1) from the back opening adjacent to the speaker main body 920L of the gaming machine 1." A person of ordinary skill in the art would understand that the substantially constant distance between two plates (e.g., 910L, 912L in FIG. 3) necessarily means that the plates are substantially parallel, as presently claimed. Thus, the specification and drawings as filed support the claimed invention.

In view of the above, withdrawal of the 35 U.S.C. 112, *first paragraph* rejection is now believed appropriate and therefore respectfully requested.

The 35 U.S.C. 103(a) rejection of all claims as being obvious over *Rasmussen* in view of *Koizumi* is also traversed for at least the reasons presented in the previous Amendments which are

incorporated by reference herein for the sake of simplicity. Notwithstanding, Applicants have amended independent claims 1 and 11 solely for the purpose of expediting prosecution.

As to independent **claims 1 and 11**, the applied references fail to teach or suggest the newly added feature “each sound generating device is coaxially fitted in the respective sound transmitting passage.” According to the descriptions on lines 33 to 36, column 3 of Koizumi, “the inner faces at the front of the sidewalls of the cabinet 1 opposing each other serve as reflecting plates 11 for reflecting sounds emitted from the speakers 3.” Therefore, Koizumi does not disclose the added feature now recited by claims 1 and 11. Advantages resulting from the distinguishing feature are as follows: The sound generating device coaxially fitted in the sound transmitting passage of the claimed invention can increase the efficiency of sound transmission, because such arrangement can prevent reflection of the sound emitted by the sound generating device. Furthermore, the trapezoidal shape of the side wall, in which the height of the sound transmitting passage increases toward the sound transmitting holes, allows flexibility in decreasing the width of the sound transmitting passage. In this way, the claimed invention can provide the sound transmitting passage that has not only the high efficiency of sound transmission but also the small width.

Accordingly, Applicants respectfully submit that amended independent claims 1 and 11 are patentable over the art.

As to independent **claim 17**, the obviousness rejection is traversed, because a *prima facie* case of obviousness has not been properly established as detailed in the previous Amendments.

The Examiner is kindly asked to provide legal authority for his obviousness rationale found at page 5, lines 12-17 that the claim feature would have been an obvious matter of design choice... since the specification has not disclosed that the claim feature solves any stated problem. Applicants’ review of the relevant section of the Office Action, i.e., page 5, lines 20-21, revealed no legal authority for the Examiner’s holding.

Applicants have previously provided Board's decisions, although not written for publication, for the Examiner's information that similar obviousness rationales have been found improper by the Board of Patent Appeals and Interferences. The Examiner's current obviousness rationale does not appear to be an exception.

Applicants also note the Examiner's reliance on *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) in page 9 of the Office Action. However, Applicants have demonstrated the criticality of the claim feature and therefore it would be improper to rely solely on case law as the rationale to support an obviousness rejection.<sup>1</sup> It is now necessary for the Examiner to provide evidence,<sup>2</sup> rather than mere reliance on case law, to show that the claim feature would have been obvious. Absence such evidence, Applicants' asserted advantages resulting from use of the claim feature preclude the Examiner's implicit conclusion that the trapezoidal shape would have been merely an obvious matter of design choice. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Applicant further note the Examiner's analysis of the criticality of the claim feature in page 8 of the Office Action, and respectfully disagree. A reason is that the prior art sound transmitting passages, which are constant in height, are not capable of performing as well as the claimed sound transmitting passages which have an increasing height. For example, as the generated sound propagates away from the sound source, it spreads radially. Therefore, the claimed trapezoidal shape of the sound transmitting passages accommodates the spreading sound better than the prior art constant height sound transmitting passages. Thus, the claim feature provides a result

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<sup>1</sup> As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection. MPEP, section 2144.04.

<sup>2</sup> "A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art." *In re GPAC, Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116,

unexpected from the constant height sound transmitting passages of the art.

Accordingly, Applicants respectfully submit that independent claim 17 is patentable over the art.

The dependent claims are considered patentable at least for the reasons advanced with respect to the respective independent claims.

As to **claim 21**, *Koizumi* teaches away from the claimed invention as detailed in the previous Amendment. The reference, therefore, cannot be properly modified to include the claim feature.<sup>3</sup>

As to **claims 22-23**, the curved sound transmitting passages of *Koizumi* would not be able to perform as well as the claimed parallel sound transmitting passages, because reflection, and hence, distortion and/or attenuation, of sound is inevitable in the curved sound transmitting passages of *Koizumi*. In contrast, the claimed parallel sound transmitting passages, coupled with their trapezoidal shape, minimize sound reflection, thereby ensuring that the sound that reaches the sound holes at the front of the gaming machine is as close to the generated sound as possible, without significant distortion and/or attenuation. The claimed parallel sound transmitting passages are therefore superior to the curved sound transmitting passages of *Koizumi*, and would not have been obvious over *Koizumi* alone or in combination with *Rasmussen*.

As to **claim 24**, note the discussion *supra* with respect to claims 1 and 11.

Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

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<sup>1</sup> 1123 (Fed. Cir. 1995).

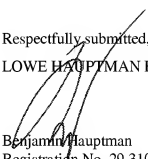
<sup>3</sup> It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). *MEPE*, section 2145.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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